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PATENT

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Michael SUTHERLAND et al.)
U.S. Application No.: 09/161,753) Group Art Unit: 3737
Filed: September 29, 1998) Examiner: A. Casiano
For: REMOVABLE MEDIA RECORDING)
STATION FOR THE MEDICAL)
INDUSTRY)

Commissioner for Patents
Washington, D.C. 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In response to the restriction requirement issued in the Office Action dated December 22, 2003, the period for response to which extends through February 23, 2004 (February 22 being a Sunday) with a one month extension of time and fee filed herewith, Applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the remarks herein.

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Election of Claim Group

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In response to the Election/Restriction Requirement, requiring election under 35 U.S.C. § 121 between the claims of:

- I. Claims 16-28, drawn to a method for enabling a proprietary or standardized medical system;

II. Claims 29-34, drawn to a medical image processing network; and,

III. Claims 35-43, drawn to a removable medium recording station

Applicant hereby elects Group I (claims 16-28) for examination.

Traversal of Restriction Requirement

Examiner Casiano and Examiner Perveen are thanked for the courtesies extended to undersigned during the telephone conferences held today. The following are the details of Applicants' traversal of the Restriction Requirement.

For proper restriction, two elements are needed: (1) the claim groups involved must be directed to independent inventions or related but distinct inventions; and, (2) reasons for insisting on restriction (e.g., different classification, different status in the art, or different field of search) must exist. MPEP 808. The examiner has failed to show the existence of the proper relationships among the claim groups required by element (1)

Independent Inventions

The determination as to whether claim groups are directed to independent inventions is made by review of the patent specification. The MPEP explains that claimed inventions are independent "where they are not connected in design, operation, or effect *under the disclosure of the particular application* under consideration." (MPEP 808.01) (emphasis added) MPEP 806.04 gives examples of independent inventions:

(A) Two different combinations, *not disclosed* as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe and a locomotive bearing would be an example. A process of painting a house and a process of boring a well would be a second example.

(B) Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

(C) Where a species under a genus are independent, for example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

(emphasis added).

The MPEP further emphasizes that “people *seldom* file an application containing disclosures of independent things” so the situation where the inventions claimed are independent “is but *rarely* presented.” (MPEP 808.01) (emphasis added)

In the present case, the examiner has divided the claims into the following groups: (I) method claims (claims 16-28), (II) network claims (claims 29-34), and (III) apparatus claims (claims 35-43), *all of which involve removable media*. Further, the *text in the patent specification* one would review to understand the subject matter of each claim group *is the same* for all claim groups and accordingly shows the claim groups must be “connected in design, operation, or effect.” In finding that claim groups I and III are independent from claim group II, the examiner fails to consider the specification, relying instead on the “different fields” to which he asserts that the claim groups are directed. In doing so, the examiner has failed to show that the claim groups are directed to independent inventions as required by element (1) of the restriction requirement.

Distinct Inventions – Combination/Sub-combination

In issuing the restriction requirement, the examiner states that the method claims group I and the network claims group II are related as combination and sub-combination. However, the combination-subcombination relationship is directed to claim groups *within the same statutory category* as illustrated in 806.05(c). When crossing statutory classes (such as process and apparatus), other sections of the MPEP govern the distinctness determination. For example,

distinctness between a process and an apparatus for its practice is governed by 806.05(e).

Applicant notes that the process, apparatus, and network claims at issue use almost identical terminology and stem from the same portions of the patent specification. Since the examiner has not shown that the method claims are distinct from the network claims, withdrawal of the restriction requirement is requested.

CONCLUSION

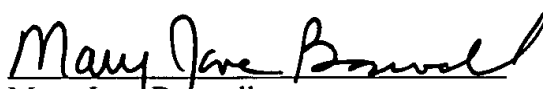
The examiner has not shown the requisite relationship among the claim groups (I, II, and III) for proper restriction. Withdrawal of the restriction requirement is requested.

Respectfully submitted,

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Dated: February 23, 2004

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